

REMARKS

Claims 1-5 and 7-36 are pending in the application. Claims 1, 8, 16, 23, 31, and 35 are independent. By the foregoing Amendment, claim 6 has been canceled and claims 1, 8, 16, 23, 31, and 35 have been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

Rejection of Claims 1-36 Under Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1-36 under obviousness-type double patenting as being unpatentable over claims 26-28 of U.S. Patent No. 6,788,724 to Sell, et al. (hereinafter "Sell") in view of U.S. Patent No. 6,754,243 to Missey is (hereinafter "Missey"). Applicant respectfully traverses the rejection.

In papers filed herewith, Applicant has submitted a Terminal Disclaimer disclaiming the terminal part of any patent granted on the above-identified application that would extend beyond the expiration of the full statutory term of United States Patent No. 6,788,724. Applicants respectfully submit that the Terminal Disclaimer overcomes the obviousness-type double patenting rejection. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 1-36.

Rejection of Claims 1-4, 8-9, 11, 13-17, 20-21, 23, and 25-28 Under 35 U.S.C. §102(e)

In paragraph 4 of the Office Action, the Examiner rejected claims 1-4, 8-9, 11, 13-17, 20-21, 23, and 25-28 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,502,131 to Vaid et al. (hereinafter "Vaid"). A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236 (Fed. Cir. 1989)). Applicant respectfully traverses the rejection.

Representative amended claim 1 recites in pertinent part "a tuning etalon positioned in a light beam, the first tuning etalon to ***define a wavelength grid*** for the optical apparatus; a tuning element positioned in the light beam, the tuning element to ***select*** from among multiple

communication channels; and a drive element magnetically coupled to said tuning etalon” (emphasis added). Representative claim 23 recites in pertinent part “*defining a wavelength grid* for the optical apparatus with the tuning etalon; positioning a tuning element in the light beam; *selecting* from among multiple *communication channels* using the tuning element” (emphasis added). Support for these changes according to at least one embodiment can be found in Applicant’s Specification at paragraphs [0028] – [0031].

Applicant respectfully submits that Danielmeyer fails to teach the identical invention as recited in claim 1. For example, Danielmeyer fails to teach both a grid generator and a channel selector in the same external cavity. Thus, Danielmeyer fails to anticipate claim 1. Because the Danielmeyer fails to anticipate claim 1, Applicant respectfully submits that claim 1 is patentable over the Danielmeyer. These elements also are recited in the main in amended independent claims 8, 16, 23, 31, and 35. Applicant respectfully submits that Danielmeyer therefore also fails to anticipate claim 1. Because the Danielmeyer fails to anticipate claims 8, 16, 23, 31, and 35 Applicant respectfully submits that claims 8, 16, 23, 31, and 35 are patentable over Danielmeyer. Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1, 8, 16, 23, 31, and 35.

Claims 4-5 properly depend from claim 1, which Applicant respectfully submits is patentable over Danielmeyer. Accordingly, Applicant respectfully submits that claims 4-5 are patentable over Danielmeyer for at least the same reasons that claim 1 is patentable over Danielmeyer. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 4-5.

Claims 27-28 properly depend from claim 23, which Applicant respectfully submits is patentable over Danielmeyer. Accordingly, Applicant respectfully submits that claims 27-28 are patentable over Danielmeyer for at least the same reasons that claim 23 is patentable over Danielmeyer. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 27-28.

Rejection of Claims 1, 4-5, 8-10, 23-24, 27-28, 31-32, and 35 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,108,355 to Zorabedian et al. (hereinafter “Zorabedian”) in view of Missey. To establish a *prima facie* case of obviousness, an Examiner must show that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teaches each and every element of the claimed invention. (MPEP §2143.) citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.1991)). Applicant respectfully traverses the rejection.

In the Office Action, the Examiner asserts with respect to claims 1, 23, and 35 that Zorabedian discloses a tuning etalon 162 positioned in a light beam and a drive element 160 driving the tuning element so that it translates up and down relative to the light beam. The Examiner concedes that Zorabedian fails to teach that the drive element 160 is magnetically coupled to the tuning element but asserts that because Missey teaches that a magnetic actuation may be done to translate an element up and down relative to a beam it would have been obvious to use magnetic actuation as an alternative means for translating the tuning element. Applicant respectfully disagrees.

Applicant respectfully submits that Zorabedian in view of Missey fails to teach the each and every element as recited in claims 1, 23, and 35. For example, Zorabedian in view of Missey fails to teach both a grid generator and a channel selector in the same external cavity. Neither Zorabedian nor Missey either alone or in combination teaches or suggests a dual means for tuning an external cavity laser. Thus, Zorabedian in view of Missey fails to render claims 1, 23, and 35 obvious. Because the Zorabedian in view of Missey fails to render claims 1, 23, and 35 obvious Applicant respectfully submits that claims 1, 23, and 35 are patentable over the Zorabedian in view of Missey. Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1, 23, and 35.

Applicant respectfully submits that Zorabedian in view of Missey fails to teach the each and every element as recited in claims 8 and 31. For example, Zorabedian in view of Missey fails

to teach both a grid generator and a channel selector in the same external cavity. Zorabedian in view of Missey also fails to teach defining a wavelength grid using the grid generator and a selecting a channel using the channel selector. Thus, Zorabedian in view of Missey fails to render claims 8 and 31 obvious. Because the Zorabedian in view of Missey fails to render claims 8 and 31 obvious Applicant respectfully submits that claims 8 and 31 are patentable over the Zorabedian in view of Missey. Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 8 and 31.

Claims 4-5, 8-10, 24, 27-28, and 31-32 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 4-5, 8-10, 24, 27-28, and 31-32 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35.

Rejection of Claims 2-3, 7, 12, 15-18, 22, 25-26, 30, 33-34, and 36 Under 35 U.S.C. §103(a)

The Examiner rejected claims 2-3, 7, 12, 15-18, 22, 25-26, 30, 33-34, and 36 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian in view of Missey as applied to the claims above in further view of U.S. Patent No. 6,396,023 to Aikiyo (hereinafter "Aikiyo"). Applicant respectfully traverses the rejection.

Applicant respectfully submits that Zorabedian in view of Missey in further view of Aikiyo fails to teach the each and every element as recited in amended independent claim 16. For example, Zorabedian in view of Missey in further view of Aikiyo fails to teach both a grid generator and a channel selector in the same external cavity. Zorabedian, Missey, and Aikiyo either alone or in combination fail to contemplate a dual means for tuning an external cavity laser. Thus, Zorabedian in view of Missey in further view of Aikiyo fails to render claim 16 obvious. Because the Zorabedian in view of Missey in further view of Aikiyo fails to render claim 16 obvious Applicant respectfully submits that claim 16 is patentable over the Zorabedian in view of Missey in further view of Aikiyo. Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 16.

Claims 2-3, 7, 12, 15, 17-18, 22, 25-26, 30, 33-34, and 36 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 2-3, 7, 12, 15, 17-18, 22, 25-26, 30, 33-34, and 36 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 2-3, 7, 12, 15, 17-18, 22, 25-26, 30, 33-34, and 36.

Rejection of Claims 2, 7, 16, 18, 22, 25-26, and 30 Under 35 U.S.C. §103(a)

The Examiner rejected claims 2, 7, 16, 18, 22, 25-26, and 30 under 35 U.S.C. §103(a) as being unpatentable over Danielmeyer in view of Aikiyo. Applicant respectfully traverses the rejection.

Applicant respectfully submits that Danielmeyer in view of Aikiyo fails to teach the each and every element as recited in amended independent claim 16. For example, Danielmeyer in view of Aikiyo fails to teach both a grid generator and a channel selector in the same external cavity. Danielmeyer and Aikiyo either alone or in combination fail to contemplate a dual means for tuning an external cavity laser. Thus, Danielmeyer in view of Aikiyo fails to render claim 16 obvious. Because the Danielmeyer in view of Aikiyo fails to render claim 16 obvious Applicant respectfully submits that claim 16 is patentable over the Danielmeyer in view of Aikiyo. Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 16.

Claims 2, 7, 18, 22, 25-26, and 30 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 2, 7, 18, 22, 25-26, and 30 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 2, 7, 18, 22, 25-26, and 30.

Rejection of Claims 13-14 and 20-21 Under 35 U.S.C. §103(a)

The Examiner rejected claims 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian in view of Missey in further view of Aikiyo in further view U.S. Patent No. 5,696,785 to Bartholomew et al. (hereinafter “Bartholomew”). Applicant respectfully traverses the rejection.

Claims 13-14 and 20-21 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 13-14 and 20-21 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 13-14 and 20-21.

Rejection of Claims 20-21 Under 35 U.S.C. §103(a)

The Examiner rejected claims 20-21 under 35 U.S.C. §103(a) as being unpatentable over Danielmeyer in view of Aikiyo. Applicant respectfully traverses the rejection.

Claims 20-21 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 20-21 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 20-21.

Rejection of Claims 6, 11, and 29 Under 35 U.S.C. §103(a)

The Examiner rejected claims 6, 11, and 29 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian and Missey in further view U.S. Patent No. 6,215,802 to Lunt (hereinafter “Lunt”). Applicant respectfully traverses the rejection.

Claims 6, 11, and 29 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 6, 11, and 29 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 6, 11, and 29.

Rejection of Claims 6 and 29 Under 35 U.S.C. §103(a)

The Examiner rejected claims 6 and 29 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian and Missey in further view U.S. Patent No. 6,215,802 to Lunt (hereinafter “Lunt”). Applicant respectfully traverses the rejection.

Claims 6 and 29 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 6 and 29 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 6 and 29.

Rejection of Claim 19 Under 35 U.S.C. §103(a)

The Examiner rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian in view of Missey in view of Aikiyo as applied to the claims above and in further view of Lunt. Applicant respectfully traverses the rejection.

Claim 19 properly depends from patentable claim 16. Accordingly, Applicant respectfully submits that claim 19 is patentable for at least the same reasons that claim 16 is patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 19.

Rejection of Claim 19 Under 35 U.S.C. §103(a)

The Examiner rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Danielmeyer in view of Aikiyo as applied to the claims above and in further view of Lunt. Applicant respectfully traverses the rejection.

Claim 19 properly depends from patentable claim 16. Accordingly, Applicant respectfully submits that claim 19 is patentable for at least the same reasons that claim 16 is patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 19.

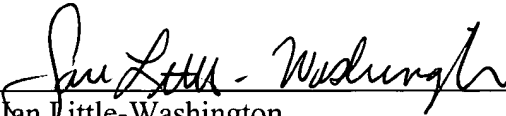
CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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